

IV. REMARKS

By this amendment, claims 1, 5, 9 and 13 have been amended. As a result, claims 1-13 are pending in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Office, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the drawings are objected to for allegedly not being referred to in the specification. Claims 1-12 are rejected under 35 U.S.C. §112 as allegedly being indefinite. Claims 1-12 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 1, 3, 5, 7, 9 and 11 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Kaplan *et al.* (U.S. Patent No. 5,594,641), hereafter “Kaplan.” Claims 2, 6 and 10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaplan in view of Lee (U.S. Patent No. 4,939,639), hereafter “Lee.” Claims 4, 8 and 12 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaplan in view of Schabes *et al.* (U.S. Patent No. 6,424,983), hereafter “Schabes.”

A. OBJECTIONS TO THE DRAWINGS

The Office has objected to the drawings for allegedly not being referred to in the specification. Applicants have amended the specification to refer to FIG. 2 and FIG. 3. No new matter has been added. Accordingly, Applicants respectfully request that the objection be withdrawn.

B. REJECTION OF CLAIMS 1-12 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Office asserts that claims 1-4 and 9-12 are incomplete for omitting essential steps. Applicants have amended claims 1 and 9 to indicate generating of a cut and paste code extended by a gloss code, as suggested by the Office. Accordingly, Applicants respectfully submit that the claims include all essential steps and request that the Office withdraw its rejection.

C. REJECTION OF CLAIMS 1-13 UNDER 35 U.S.C. §101

The Office has rejected claims 1-13 for allegedly being directed to non-statutory subject matter. Specifically, the Office asserts that the claimed invention does not result in a physical transformation or produce a useful, concrete, and tangible result. Applicants have amended claims 1 and 9 to include “generating” as suggested by the Office. Further, Applicants have amended claim 5 to include a computer. Applicants respectfully submit that these amendments satisfy the Office’s definition of statutory subject matter. Accordingly, Applicants request that the rejection be withdrawn.

D. REJECTION OF CLAIMS 1, 3, 5, 7, 9, 11 AND 13 UNDER 35 U.S.C. §102(b)

With regard to the 35 U.S.C. §102(b) rejection over Kaplan, Applicants continue to assert that Kaplan does not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 5, and 9, Applicants submit that Kaplan fails to teach a cut and paste code extended by a gloss code. The Office cites a passage of Kaplan that it asserts describes tag codes including those that indicate a change in case. However, nowhere in the passage of Kaplan cited by the Office is it indicated that the tag codes include both an indication of how many characters should be cut from the end of a surface form of a word and an indication of whether at least part of the orthographic variation should be converted between upper and lower case in a single extended code. The Office further cites a passage of Kaplan that it says describes an example of case variation. However, the passage of Kaplan cited by the Office merely uses capital letters as an illustration of how the prefix “im” can mean the same thing as “in” by referring to the same lexical forms iNpractical and iNtractable. To this extent, the capitals in the words in the passage of Kaplan cited by the Office do not indicate whether at least part of the orthographic variation should be converted between upper and lower case.

In contrast, the claimed invention includes “...storing, for each of the orthographic variations, a cut and paste code, which indicates how many characters should be cut from the end of a surface form of a word and pasted to produce a particular variation, extended by a gloss code that indicates whether at least part of the orthographic variation should be converted between upper and lower case..” Claim 1. As such, in contrast to Kaplan, the claimed invention includes a gloss code that extends a cut and paste code. Thus, even with the Office’s example, the tag

codes of Kaplan do not teach the cut and paste code extended by the gloss code of the claimed invention. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to newly amended claim 13, Applicants respectfully submit that the references cited by the Office fail to teach or suggest that the extended code is adapted to allow a single orthographic variation to indicate a variation for a plurality of root words. In contrast, in Kaplan, a single entry applies only to a single root word. Accordingly, Applicants respectfully request that the rejection be withdrawn.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of this rejection.

E. REJECTIONS 35 U.S.C. §103(a)

With regard to the Office's arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to independent claims listed above. In addition, Applicants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserves the right to do so should it become necessary. Accordingly, Applicants respectfully request that the Office withdraw its rejections.

VI. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



Date: January 30, 2007

Hunter E. Webb
Reg. No.: 54,593

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

RAD/hew